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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,104	11/15/2000	Eiichi Sato	B422-143	9652
26272	7590	07/09/2004	EXAMINER	
ROBIN BLECKER & DALEY 2ND FLOOR 330 MADISON AVENUE NEW YORK, NY 10017			MOORTHY, ARAVIND K	
			ART UNIT	PAPER NUMBER
			2131	6

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/713,104

Applicant(s)

SATO, EIICHI

Examiner

Aravind K Moorthy

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2\_4
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-20 are pending in the application.
2. Claims 1-20 have been rejected.

***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Method and Apparatus for Discriminating the Secrecy Level Information of Received Data.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-7, 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Schneider et al U.S. Patent No. 6,105,027.

As to claims 1, 9 and 10, Schneider et al discloses a communication apparatus for transferring data received from a first network to a second network, the apparatus comprising:

first discrimination means for discriminating the destination information of the received data [column 26, lines 28-61];

second discrimination means for discriminating the secrecy level information of the received data; and

control means for executing the transfer of the received data, according to the result of discrimination by the first and second discrimination means [column 17 line 66 to column 18 line 12].

As to claim 2, Schneider et al discloses that the control means transfers the received data with encryption, according to the discrimination by at least either of the first and second discrimination means [column 21, lines 15-52].

As to claim 3, Schneider et al discloses that the secrecy level information includes whether the received data are confidential data [column 17 line 66 to column 18 line 12].

As to claim 4, Schneider et al discloses that the control means transfers the received data to the destination by e-mail, according to the discrimination by at least either of the first and second discrimination means [column 25, lines 15-43].

As to claim 5, Schneider et al discloses that the control means stores the received data in a predetermined memory, according to the discrimination by at least either of the first and second discrimination means [column 21, lines 15-52].

As to claim 6, Schneider et al discloses that the destination information includes whether encryption information corresponding to the destination is provided [column 26, lines 28-61].

As to claim 7, Schneider et al discloses that the destination information includes path information to the destination for the received data [column 26, lines 28-61].

**5. Claims 11-13, 15, 16, 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Inoue et al U.S. Patent No. 6,167,513.**

As to claims 11, 19 and 20, Inoue et al discloses a communication apparatus for transferring data received from a first network to a second network, the apparatus comprising:

discrimination means for discriminating whether encryption information corresponding to the destination of the received data is present [column 12, lines 65-67]; and

control means for executing control whether to transfer the received data with encryption based on the encryption information corresponding to the destination, or to store the received data in a predetermined memory [column 13, lines 38-60].

As to claim 12, Inoue et al discloses that the control means transmits, to the destination, a message indicating that the received data are stored in a predetermined memory [column 17, lines 35-47].

As to claim 13, Inoue et al discloses that the encryption information is acquired from the destination [column 20, lines 35-61].

As to claim 15, Inoue et al discloses that the control means is adapted, upon acquiring the encryption information from the destination, to encrypt the received data stored in the predetermined memory with the encryption information and to execute transfer to the destination [column 20 line 62 to column 21 line 21].

As to claim 16, Inoue et al discloses the control means executes the encryption according to the transfer path to the destination [column 20 line 62 to column 21 line 21].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al U.S. Patent No. 6,105,027 as applied to claim 1 above, and further in view of Perlman U.S. Patent No. 6,363,480 B1.**

As to claim 8, Schneider et al does not teach that the destination information includes whether the encryption information corresponding to the destination is within an effective period.

Perlman teaches information that teaches whether encryption information is within an effective period [column 6 line 58 to column 7 line 8].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneider et al so that the destination information in the header would have included encryption information corresponding to the destination was within an effective period.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Schneider et al by the teaching of Perlman because it permits selection of an appropriate decryptability lifetime for specific units of data, such as electronic mail messages. Further, where one or more third party ephemeral systems are used to provide ephemeral keys to encrypt a message, such third party ephemeralizers may be employed

to destroy the ephemeral keys at their expiration times, without burdening the communicating parties with this responsibility [column 4, lines 18-27].

**7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al U.S. Patent No. 6,167,513 as applied to claim 11 above, and further in view of Rahtgen U.S. Patent No. 4,882,779.**

As to claim 14, Inoue et al does not teach that the control means executes the encryption according to the secrecy level of the received data.

Rahtgen teaches encrypting according to a level of secrecy [column 13 line 56 to column 14 line 3].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Inoue et al so that the control means would have executed the encryption according to the secrecy level of the received data.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Inoue et al by the teaching of Rahtgen because it eliminates the risk of providing transparency to the first data system or the high secrecy and high security data system from the second data system or the low secrecy and low security data system, as, on the one hand, regarding the first data system, i.e. the high secrecy and high security data system, the personal authentication code is output to the first data system, in an encrypted state exclusively, which in itself guarantees the high security and high secrecy level, and on the other hand, regarding the second data system, i.e. the low secrecy and low security data system [column 3, lines 48-67].

**8. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al U.S. Patent No. 6,167,513 as applied to claim 11 above, and further in view of Perlman U.S. Patent No. 6,363,480 B1.**

As to claims 17 and 18, Inoue et al does not teach that the encryption information includes an effective period. Inoue et al does not teach that the effective period of the encryption information is renewable.

Perlman teaches encryption information that includes an effective period Perlman teaches that the effective period of the encryption information is renewable [column 6 line 58 to column 7 line 8].

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Inoue et al so that the encryption information would have included an effective period. The effective period of the encryption information would have been renewable.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Inoue et al by the teaching of Perlman because it permits selection of an appropriate decryptability lifetime for specific units of data, such as electronic mail messages. Further, where one or more third party ephemerizer systems are used to provide ephemeral keys to encrypt a message, such third party ephemerizers may be employed to destroy the ephemeral keys at their expiration times, without burdening the communicating parties with this responsibility [column 4, lines 18-27].




*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K Moorthy whose telephone number is 703-305-1373. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy  
June 29, 2004

  
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